In the

Supreme Court of the United States

October Term, 1941

No. 217

LESTER W. BAILEY,
Petitioner,

v.

SEARS ROEBUCK & CO.,
Respondent.

RESPONDENT'S BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

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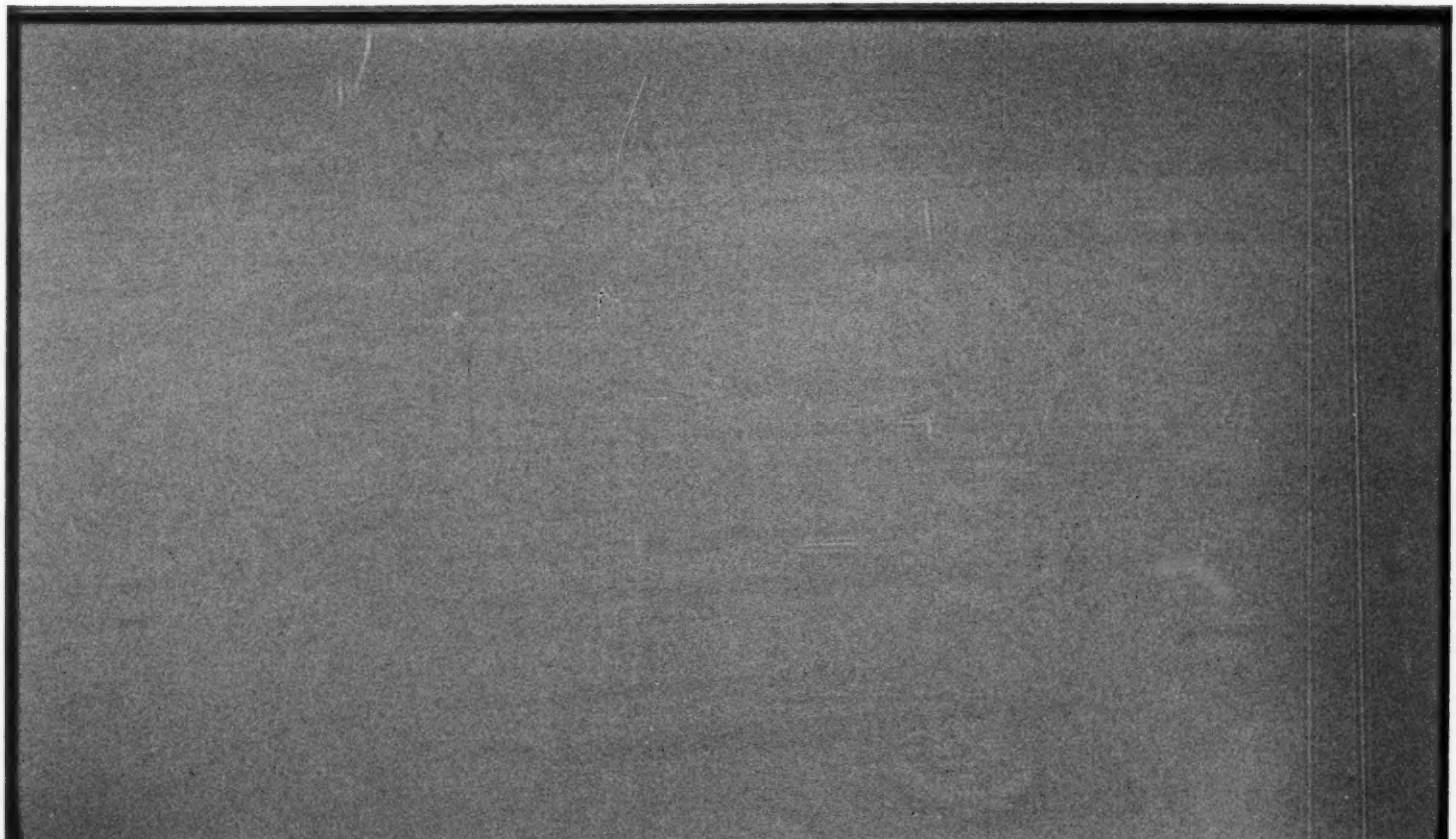

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The petition does not present any question on which varying views have been expressed by different courts, or any question of general or public importance. The suit is an ordinary one for alleged patent infringement, in which a special master, a District Court and an unanimous Circuit Court of Appeals concluded that a "gadget" patent on a dial for a radio broadcast receiver was invalid for lack of patentable invention. There is no sound reason why this Court should grant the writ, and the suit was rightly decided.

OPINIONS BELOW

The special master's report was that the patent was invalid, and that it was not infringed by two models of radio

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Italics ours throughout brief.

broadcast receivers but infringed by another model if the patent were valid (1 R. 18 *et seq.*); the District Court opinion was that the patent was invalid without making any finding as to infringement (unreported; 1 R. 85); and the Circuit Court of Appeals for the Ninth Circuit held that the patent was invalid (115 F. 2d. 904; 1 R. 508), denying a petition for rehearing (not reported; 1 R. 518).

The ground for the decisions that the patent was invalid was lack of patentable invention.

The Master.

> "The patent does not disclose invention but is a natural and obvious forward step involving merely mechanical adaptation and improvement and is invalid because not disclosing invention" (1 R. 40).

The District Court.

> "The Report is confirmed insofar as it finds the device of plaintiff was not patentable" (Opinion, 1 R. 85).

The Circuit Court of Appeals.

> "Hence, it was not patentable as a combination of old elements." (1 R. 515; 115 F. 2d. 904, 906).
>
> "Hence, we hold there was no invention in the patent under consideration." (1 R. 516; 115 F. 2d. 904, 907).

The petition for certiorari seeks a reversal of these conclusions.

The patent has not been elsewhere litigated, so that there is no conflict of decision as to it.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

The petition (p. 4) asserts that there are two "Questions Presented", as follows:

> "1. Where new functions and results are not set forth in a patent but are inherent in the structure claimed in the patent shall they be considered as evidence of patentability?
>
> 2. Does the record in this case show that Respondent has sustained its burden of proof by showing that the claims in suit or either of them are invalid?"

The second "Question Presented" is merely whether the evidence justified the concurrent decisions below that the prior art invalidated the Bailey patent.

The first "Question Presented" is apparently the one relied upon by petitioner, his petition stating that the "Reasons relied on for Issuance of Writ" (petit., p. 4):

> "is that the Ninth Circuit has decided an important question of Federal Law in a way probably in conflict with applicable decisions of the Supreme Court, or that this question has not been but should be decided by the Supreme Court.
>
> The first question raised by the petition goes to the content of all patents and patent applications."

But the present case was not decided upon the basis of the first question, nor is it even presented. A primary defense, sustained by the courts below, was that claims of the Bailey patent were invalid for lack of invention over the prior patents. Only incidentally did respondent state

that certain of the alleged functions, results and advantages of the Bailey patent were non-existent, citing as evidence thereof the absence of any reference to them in the patent. On this point, the Circuit Court of Appeals said:

> "It is true, as appellant states, that a patent need not set out all of the uses and advantages of the patent.", citing cases (1 R. 513; 115 F. 2d. 904, 906).
>
> "Appellant claims new functions are performed by his device. * * * None of these matters are set out in, or taught by, the patent, nor does it appear that such functions are new or novel over the prior art." (1 R. 515; 115 F. 2d. 904, 907).

Apparently, petitioner complains of the last quoted matter. But the Court was right in pointing out that the failure of the Bailey patent to mention an advantage or function, asserted by petitioner and denied by respondent, was significant with respect to the alleged existence of the alleged advantage or function. As stated in *Ball & Socket Fastener Co.* v. *Kraetzer,* 150 U. S. 111, 116:

> "If this feature be an advantage, as now claimed, it is strange that no allusion is made to it in the specifications."

Lincoln Engineering Co. v. *Stewart-Warner Corp.,* 303 U. S. 545, 550:

> "The suggestion seems to be an afterthought. No such function of the nipple is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted."

And the ground for the decisions below was not the patent's failure to describe certain functions—it was its

lack of patentable invention. Thus the reason urged for allowance of the writ, even if it existed, does not touch the substance of the case.

In this connection, petitioner's brief says (p. 15):

> "Mr. Bailey testified to a number of new functions and results inherent in his structure over the prior art of which Rysman is the most pertinent representative. None of his testimony was contradicted and it stands undisputed in the record."

And again (p. 23): "Mr. Bailey's undisputed testimony about new functions and results". But Bailey's testimony was contradicted and successfully, by the testimony of Dr. Cutting, an eminent authority in the radio field, and by Newman, a radio engineer with the Radio Corporation of America.

The alleged new functions and results relate to the details of ratios, translatory motion, parallax, flexible drive, slip clutch, dual ratio and production parts (petitioner's brief, p. 16 *et seq.*), which are not even mentioned in the patent claims. The testimony of Newman and Cutting contradicted Bailey with respect to "ratios" (Cutting, 1 R. 154), "translatory motion" (Cutting, 1 R. 232) and "parallax" (Newman, 1 R. 145, Cutting, 213, 214, 250); a "flexible drive" (the pulley and cord drive of Bailey) is used in two but not the other of respondent's three models complained of (2 R. 486, 487, 488); neither a "slip clutch" nor "a dual ratio" is disclosed in the Bailey patent; and Bailey's attempt to testify concerning "production gears" (1 R. 257) was shown on cross examination (1 R. 318) to be without knowledge of the facts and of no evidential value.

THE DECISION BELOW WAS CORRECT

The Bailey patent describes a radio dial with two pointers, like a clock, to indicate a transmitting station. As in a clock, the two pointers are actuated by a driving shaft, one pointer being directly on the shaft and the other pointer being on a sleeve around the shaft, the sleeve being driven by gears from the shaft. The specific gear train proposed by Bailey consists of a gear on the shaft, a gear on a countershaft, another gear on the countershaft, and a gear on the sleeve. This was an old type of gear drive, and is shown in the prior patents of Rysman, Huth and McKenzie, hereinafter discussed.

The gear train between the shaft and its sleeve obviously may be of any desired ratio. If the gearing is step-up (motion-multiplying), the sleeve and its pointer will rotate faster than the shaft and its pointer. If the gearing is step-down (motion-dividing), the sleeve and pointer will rotate slower.*

About 1934 and for perhaps two or three years later, the ephemeral fashion of radio cabinet design made popular the clock face dial (Meissner, 1 R. 118; Newman, 1 R. 128; Cutting, 1 R. 211, 212). But the fashion ended even before the trial, in January 1938 (Bailey, 1 R. 110, 111; Newman, 1 R. 128; Cutting, 1 R. 213, 249), and today there are few, if any, models of radio receivers on the market with such dials.

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*A driving gear which meshes with a gear one-half its size will cause the latter to rotate twice to the driving gear's once, while if the driven gear is twice the size, the latter will rotate at only half the speed of the driving gear. In the first case, the gear ratio is termed step-up or motion-multiplying, and in the second case, step-down or motion-dividing.

And Bailey did not invent a clock face dial for radio receivers, this being shown in the Hall British patent 278,793, Fig. 2 (2 R. 468), and the Rysman French patent 571,362 (2 R. 473). Bailey admitted (1 R. 324):

> "Q. It was old, was it not, to have dial mechanism in which there was a clock face dial, a fast pointer, a slow pointer, rotors, and a knob which moved the two pointers, and the condenser rotors at certain predetermined ratios? A. Yes, that is true."

The "rotors" and the "condenser rotors" refer to the rotor plates, which are used in radio broadcast receivers for tuning the set to receive a desired transmitting station.

The specific improvement claimed by Bailey was a step-up gear ratio, instead of a step-down gear ratio, between the shaft and its sleeve.

Of course, gear drives and ratios were old long before Bailey (Cutting, 1 R. 176). Bailey testified (1 R. 324):

> "Q. Do you claim to have discovered anything with respect to gear ratios?
> A. No. That is an old art."

The application for the Bailey patent was filed with ten claims (2 R. 399). The Patent Office Examiner cited the Rysman patent and rejected all claims, because not "patentable over the reference" (2 R. 405).

The Rysman patent (2 R. 469) discloses a clock dial, with pointers for indicating radio condenser operation, the condenser rotor shaft carrying one pointer and driving (through gears and a countershaft) another pointer on a sleeve around the shaft. In each of these main features, Rysman is exactly like Bailey. The only difference is in the non-patentable detail that in Rysman the gears are *step-*

down from shaft to sleeve, while in Bailey, the gears are *step-up*.

Upon this citation of the Rysman patent, Bailey cancelled all his proposed claims and submitted claim 1 of the patent (2 R. 405), saying that in the Bailey device "This movement of the shaft 6, through the disclosed gear train, *steps up or multiplies* the movement of the fine adjustment indicating hand 28," and that "The claim also defines the gears as comprising a *motion multiplying* train, whereas in the reference it is the reverse" (2 R. 406). This claim was then allowed.

Bailey then filed an amendment, adding claim 2 of the patent, saying (2 R. 407):

> "This claim emphasizes that the sleeve which carries the fine adjustment pointer is operated at a predetermined speed greater than that of the coarse adjustment pointer, and that the *motion multiplying* means for actuating the sleeve and fine adjustment pointer is operatively connected", etc.

Claim 2 was then allowed.

It is plain that the patent was granted on a mere difference between step-up gearing and step-down gearing (both being old).

Faiella patent 1,216,556 (2 R. 430) describes two alternative ways of driving an hour hand and a minute hand of a watch, one using step-up gearing and the other step-down gearing. A hollow shaft, with a pointer on it, drives through gears, a sleeve around the shaft, this sleeve also carrying a pointer. In Figs. 1, 2 and 3 of the Faiella patent, the gearing is step-down, so the sleeve revolves slower. In Figs. 4 and 5, the gearing is step-up (as in the Bailey patent).

The Faiella patent shows that step-up gears and step-down gears are equivalents. Of course, the most obvious place to look for mechanism to drive two pointers over a dial at a fixed ratio with respect to each other, as in the Bailey patent, is a clock or watch, as petitioner's witness Lawson testified (1 R. 375):

> "Q. Suppose in 1932 you were asked to build a clock dial with two hands like the minute hand of a clock and the hour hand of a clock, and you were told that the minute hands were to be related to the condenser knob and there was to be a tuning dial; and assuming also you could look at clocks, as you naturally would, wouldn't you? A. Absolutely.
>
> "Q. That was the first thing you would do, would be to look at a clock or watch with the two hands, and one on the sleeve and the other on the shaft; that is right, is it not? A. That is correct.
>
> Q. And if you had clock patents you would look at the clock patents as well the clock construction, wouldn't you, if you were told to do that? A. That is right."

Meirowsky patent 1,538,487 (2 R. 433) describes a radio condenser with two geared pointers, one fast and the other slow (Cutting, 1 R. 162), for the same purpose as Bailey, namely, "to obtain an exact reading of the adjustments of the movable plate" (Meirowsky pat., 2 R. 436). The gearing is not the same as in Bailey and there are two dials, one for each pointer, the pertinence of the Meirowsky patent being to show that it was known before Bailey to use for radio condensers two interconnected pointers for fine and coarse indication.

Huth patent 1,601,968 (2 R. 445) discloses a radio tuning dial with the same gear train as Bailey (Cutting,

1 R. 166). It is true that Huth uses this gear mechanism between the tuning knob and the condenser shaft, and not, as in Bailey, to operate two pointers. However, it would not require inventive genius to use the Huth gearing with a two pointer dial.

McKenzie British patent 22,505 (2 R. 448) discloses a clock dial with two pointers, and the same step-up driving mechanism (shaft, countershaft and sleeve) as in Huth and Bailey. The mechanism is used to adjust the cutting tool in a lathe to its desired position, as shown by the two pointers on the dial (Cutting, 1 R. 170), just as in a radio receiver the rotors of a tuning condenser are adjusted to the desired position, as shown by the pointer or pointers on the dial.

Hall British patent 278,793 (2 R. 458) describes a radio condenser dial, with two pointers, for the same purpose as Bailey (Cutting, 1 R. 171 *et seq.*) A shaft drives its sleeve, the specific type of gearing between the shaft and the sleeve being different from that of Bailey. In Fig. 8 of the Hall patent, this gearing is the well known planetary drive of the old Model T Ford (Ex. 27a; 2 R. 484). There are, of course, many different ways of driving two pointers in a fixed ratio, and a patent cannot be validly issued for any one of the many equivalent mechanisms.

Siemens & Halske German patent 324,785 (2 R. 474) shows a radio tuning mechanism, with two dials, each having a pointer, and interconnected so as to provide both a fine reading and a coarse reading (Cutting, 1 R. 178). One dial is stationary and its pointer movable, while the other dial is movable and its pointer stationary. This type was fashionable for a time, the Radio Corporation of America selling more than 50,000 receivers having such dials (Newman, 1 R. 129 *et seq.*).

None of the foregoing patents, except the Rysman patent, was before the Patent Office during the prosecution of Bailey's application for patent. If they had been, it is at least probable that the Bailey patent would not have issued.

There is no mechanical or other advantage in using a step-up gearing between shaft and sleeve to operate two indicating pointers, as in Bailey, Figs. 4 and 5 of Faiella and McKenzie, as distinguished from a step-down gearing, as in Figs. 1, 2 and 3 of Faiella, Hall and Rysman. In 1933 the Radio Corporation of America used a step-up ratio, and in 1937 a step-down ratio (Newman, 1 R. 127), both being successful and the reason for the change being merely the particular location of the condenser in the 1937 radio receiver (Newman, 1 R. 127, 141).

CONCLUSION

The controlling issue in the present case was whether or not the Bailey patent disclosed inventive genius, or as recently said by this Court in *Detrola Radio & Television Corp.* v. *Hazeltine Corp.,* 61 Sup. Ct. Rep., p. 948 "required only the exercise of the skill of the art". The courts below were correct in deciding that there was no patentable invention, and no reason appears for the grant of a writ of certiorari.

The petition should be denied.

Respectfully submitted,

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